

REMARKS

Applicant has studied the Office Action dated March 6, 2008. Claims 1-9, 11-14, 16, 18-29, 31, and 32 are pending. Claims 1-9, 11-14, 16, 18-22, 29, 31, and 32 have been amended and claims 10, 15, 17 and 30 have been canceled without prejudice. Claims 1, 12, and 21 are independent claims. No new matter has been added as the amendments have support in the specification as originally filed.

It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Amendments to the Claims

Claims 1-9, 11-14, 18-22, 29, and 32 have been amended to correct typographical or grammatical errors or to more clearly disclose the invention. Claims 11, 16, 18 and 31 have been amended to correct dependency in view of canceled claims. It is respectfully submitted that the amendments have support in the application as originally filed.

§ 102 Rejections

Claims 1-3, 5-22, and 27-31 were rejected under 35 U.S.C. § 102(b) as being anticipated by Universal Mobile Telecommunication System (UMTS) Radio Resource Control (RRC) protocol specification, 3GPP TS 25.331, version 3.10.0 Release 1999 ("the UMTS spec."). Applicant respectfully disagrees with the Examiner's interpretation of the UMTS spec. and respectfully traverses the rejection.

It is respectfully noted that a proper rejection for anticipation under § 102 requires complete identity of invention. The claimed invention, including each element thereof as recited in the claims, must be disclosed or embodied, either expressly or inherently, in a single reference. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1369, 21 U.S.P.Q.2d 1321, 1328 (Fed. Cir. 1991).

With this paper, claims 10, 15, 17 and 30 have been canceled without prejudice. It is, therefore, respectfully submitted that the rejection is moot with respect to claims 10, 15, 17 and 30 and it is respectfully requested that the rejection be withdrawn.

With regard to the rejection of independent claims 1, 12, and 21, it is respectfully noted that claims 1, 12, and 21 have been amended to recite means for verifying integrity of the received security setup control message by generating an expected authentication value using security variables included in the received security setup control message and comparing the expected authentication value to the reference authentication code, verifying integrity of the received security setup control message by generating an expected authentication value using security variables included in the received security setup control message and comparing the expected authentication value to the reference authentication code, and a processing unit verifying integrity of the security setup control message by generating an expected authentication value using security variables included in the received security setup control message and comparing the expected authentication value to the reference authentication code, respectively.

At paragraph 3 on pages 2-3 of the Office Action, the Examiner asserts that page 93, section 8.1.12.3.1 and page 95, section 8.1.12.4a of the UMTS spec. discloses the features of “verifying the integrity of the message, and processing the message and updating the value of at least one security variable with new security setup information if the message is verified, and discarding the message and leaving the value of the at least one security variable unchanged if the message is not verified.” However, it is respectfully submitted that page 93, section 8.1.12.3.1 and page 95, section 8.1.12.4a of the UMTS spec. fails to disclose the above mentioned features of independent claims 1, 12 and 21.

In particular, it is respectfully noted that page 93, section 8.1.12.3.1 of the UMTS spec. merely discloses the process when receiving a new security key set. It is further respectfully noted that page 93, section 8.1.12.3.1 of the UMTS spec. discloses that the UE sets the START value to zero and starts using the new integrity key, thus updating the value of the security variable regardless of the integrity of the received message.

Moreover, it is respectfully noted that page 95, section 8.1.12.4a of the UMTS spec. merely discloses a case in which the variable INCOMPATIBLE_SECURITY_RECONFIGURATION is set to TRUE. However, the disclosed case in which the variable INCOMPATIBLE_SECURITY_RECONFIGURATION is set to TRUE is totally different from the case in which the integrity of the security setup control message is not verified.

As clearly recited in independent claims 1, 12 and 21, the integrity of the received security setup control message is verified by generating an expected authentication value using security variables included in the received security setup control message and comparing the expected authentication value to the reference authentication code. However, the disclosure is that the variable INCOMPATIBLE_SECURITY_RECONFIGURATION is set to TRUE when the UE (or any other party) receives an incompatible simultaneous security reconfiguration message. Therefore, the disclosure is quite different from the case recited in independent claims 1, 12, and 21 in which the integrity of the received security setup control message is not verified and the generated expected authentication value is different from the received reference authentication code.

Moreover, the UMTS spec. fails to disclose even the recited feature of generating an expected authentication value using security variables included in the received security setup control message, and comparing the expected authentication value to the reference authentication code. With regard to the recited feature of generating an expected authentication value using security variables included in the received security setup control message, previously recited in canceled claims 10, 15, and 30, the Examiner asserts, at paragraph 3 of the Office action, that the UMTS spec. discloses the features originally recited in claims 10, 15, and 30, which have been canceled without prejudice, citing page 93, section 8.1.12.3.1. It is respectfully noted that the Examiner did not indicate each element in the cited reference that is considered to be equivalent to each element recited in the claims, thus lacking complete identity of the invention.

Applicant's review of the cited portions in the UMTS spec. reveals that the cited portion merely discloses the process for receiving a new security key set and the process for a UE to set the START value to zero and to start using the new integrity key. However, it is respectfully submitted that contrary to the Examiner's assertion, the cited UMTS spec. fails to disclose or suggest, at least, generating expected authentication value using security variables included in the received security setup control message, as presently recited in amended independent claims 1, 12, and 21 and previously recited in canceled claims 10, 15, and 30.

In addition, with regard to the feature of comparing the expected authentication value to the reference authentication code, it is respectfully noted that the Examiner cited the same portion of the UMTS spec. that was cited in connection with the above discussed rejection of claims 1, 12, and 21. However, it is respectfully submitted that the UMTS spec. fails to disclose

or suggest comparing the expected authentication value to the received reference authentication code, as recited in independent claims 1, 12, and 21.

Furthermore, with regard to the rejection of claims 11, 16, and 31, which originally depended from canceled claims 10, 15, and 30, respectively, it is respectfully noted that the Examiner cited the same portion of the UMTS spec. that was cited in connection with the above discussed rejection of claims 1, 12, and 21. However, it is respectfully submitted that the UMTS spec. fails to disclose or suggest the means for verifying the integrity of the received security setup control message comprises a standardized integrity check authentication generation algorithm, performing a standardized integrity check authentication generation algorithm, and the processing unit comprises a standardized integrity check authentication generation algorithm, as recited in claims 11, 16, and 31, respectively.

Moreover, with regard to the rejection of claim 18, which ultimately depends from amended independent claim 12, it is respectfully noted that the Examiner cited the same portion of the UMTS spec. that was cited in connection with the above discussed rejection of claims 1, 11, 12, 16, 21, and 31. However, it is respectfully submitted that the UMTS spec. fails to disclose or suggest the security setup control message is processed if the received reference authentication code is equal to the expected authentication value and the security setup control message is discarded if the received reference authentication code is not equal to the expected authentication code, as recited in claim 18.

Therefore, it is respectfully asserted that independent claims 1, 12, and 21 are allowable over the cited reference. It is further respectfully asserted that claims 2, 3, 5-9, and 11, which depend from claim 1, claims 13, 14, and 16-20, which depend from claim 12, and claims 22, 27-29, and 31, which depend from claim 21, also are allowable over the cited reference, at least, by virtue of their dependence from an allowable base claim in addition to the distinct features recited in at least claims 11, 16, 18, and 31 as discussed above.

§ 103 Rejections

Claims 4, 23-26, and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the UMTS spec. in view of well-known prior art. This rejection is respectfully traversed.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be

overturned. As the court recently stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. ‘A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.’ If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned.” (citations omitted.)

As asserted above, independent claims 1, 12, and 21 are allowable over the UMTS spec. It is further respectfully submitted that the well-known prior art fails to cure the deficiencies of the UMTS spec. with regard to independent claims 1, 12, and 21. Therefore, it is respectfully asserted that claims 4, which depends from claim 1, and claims 23-26, and 32, which depend from claim 21, also are allowable over the cited combination of references by virtue of their dependence from their respective allowable base claims.

CONCLUSION

In light of the above remarks, applicants submit that claims 1-9, 11-14, 16, 18-29, 31, and 32 are in condition for allowance. Reconsideration of the application, as amended, is requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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